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NGUYEN, TAN D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/863,476

Applicant(s)

SHINKAI, YASUHIRO

Examiner

Tan Dean D. Nguyen

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed 7/17/08 has been entered.

Claim Status

1. Claims 1-13, 15-24 are active and are rejected below. Claim 14 has been canceled. The claims include: claims 1-5, 16-18, 19-20 (system¹), 6-9, 12, 15 and 21 (system²), 10, 22 (method¹), 11, 13, 23 (method²) and 24 (system³).

2.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 10, 22 and 11, 13 and 23 are rejected under 35 U.S.C. 101 because in order for a method to be considered a "process" under §101, a claimed process must either:

(1) be tied to another statutory class (such as a particular apparatus) or

(2) transform underlying subject matter (such as an article or materials). See

Diamond v. Diehr, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 10, 22 and 11, 13 and 23, the claim language does not include the required (1) tie or (2) transformation, and thus is directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-5, 16-20 (system), 10, 22 (method), 6-9, 12, 15, 21 (system) and 11, 13, 23 (method) and 24 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over WINTER et al alone or further in view of SEVCIK et al.**

As of 7/17/2008, independent system claim 1 is as followed:

1. (currently amended): A print order acceptance system for accepting an order for printing images on the basis of digital image data, wherein the system comprises:

a) an order acceptance ~~machine which~~ accepts means for accepting digital image data and order information and ~~transfers~~ for transferring the image data and the order information to an image printer; and

b) a voucher printer which is separate from the image printer and which prints a voucher including thumbnail images as high resolution data and details of an order on the basis of the order information, the thumbnail images corresponding to image data which have been accepted by the order acceptance ~~machine~~ means and have been transferred to the image printer.

Note: for convenience, letters (a) and (b) are added to label each element above.

6. Note: claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not

differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

1) This is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "for transferring the image data and the order information to an image printer" in element (a) carries no patentable weight.

2) Also, in element (b), the phrase "which prints a voucher including thumbnail images as high resolution data and details of an order on the basis of the order information, the thumbnail images corresponding to image data which have been accepted by the order acceptance ~~machine~~ means and have been transferred to the image printer" is reciting like a method step and is considered as manner of operating the voucher printer and thus having no patentable weight as indicated above.

3) Similarly, in claim 6, which has similar limitation in (a), it's interpreted for the same reason set forth in item (1) above.

4) Similarly, in claim 6, element (b), the phrase "which transmitsto the image printer", which has similar similar issue as item (2) of claim 1, it's interpreted for the same reason set forth in item (2) above.

5) Similarly, in claim 24, which has similar limitation in (a), it's interpreted for the same reason set forth in item (1) above.

6) Similarly, in claim 6, element (b), the phrase "which prints a voucher ... to the image printer", which has similar issue as item (2) of claim 1, it's interpreted for the same reason set forth in item (2) above.

Independent method claim 10 is as below:

10. (previously presented): A print order acceptance method for accepting an order for printing images on the basis of digital image data, wherein the method comprises the steps of:

- a) transferring to an image printer ordered image data and order information; and
- b) instructing a voucher printer, which is separate from the image printer, to print a voucher including thumbnail images prepared on the basis of high-precision image data and details of the order on the basis of the order information, the thumbnail images corresponding to image data which have been transferred to the image printer.

7. Note: In claim 1, step (b), the phrase "to print a voucher including thumbnail images prepared on the basis of high-precision image data and details of the order on the basis of the order information, the thumbnail images corresponding to image data which have been transferred to the image printer" is not a positively recited method step but, rather, is mere intended use of the instructed printer and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps. If a printing step is required in step (b), then there should be another step calling for "printing a voucher including....".

Similarly, in claim 11, the phrase "...prepared on the basis ... and the order information" is not a positively recited method step.

Similarly, **WINTER et al** discloses a print order acceptance system/method for accepting an order for printing images on the basis of digital image data, comprising elements/steps of:

a) an order acceptance machine which accepts digital image data and order information and transfers the image data and the order information to an image printer (first printer); and

{see Fig. 1, Fig. 7, }

b) another printer to generate a combination of the customer proof sheet and order form 58 (Fig. 4) for that particular thumbnail image on a single sheet of paper when the user filling in the bubble next to "Cstm" which causes the ink jet printer 14 to generate a combination above.

{see Fig. 3A, Fig. 4, col. 4, lines 30-60, col. 5, lines 50-60}.

As for the limitation that the printer in (b) is separate from the printer (a), WINTER et al discloses the uses of various printers for performing the desired output on col. 3, lines 60-67, "laser printer, inkjet printer, dot matrix printer, thermal printer, etc. to produce a suitable quality image...", and the difference pixels required for thumbnail images vs. final print in cols. 5-7, it would have been obvious to use a separate printer in element (b) to reduce cost or for convenience so that the two functions can be carried out at the same time instead of waiting for the other job if desired. Also, the teaching of "To make separable" a function or device is well known legal precedent and it would

have been obvious to separate the printer into 2 separate printers for convenience if desired.

In a similar printing job, **SEVCIK et al** is cited to teach the concept of confirming a job after customer order wherein the confirming order including details of the orders such as the printing selections and ordered information and billing information and displaying the "confirming job" information to the customer prior to carrying out the job to inherently obtain the well known benefits of eliminating wastes due to carrying out the job using wrong information or not customer desired job or information {see Fig. 7, right hand picture, "Are you sure you wish to begin this job"}.

It would have been obvious modify the teachings of WINTER et al by modifying the ordering feature to include a confirming feature prior to carrying out the printing job as taught by SEVCIK et al above to obtain the inherent benefit of eliminating waste due to wrong order and wherein the confirmation is a combination of proof sheet which include ordered thumbnail images and order form contains other relevant information such as ordered information as taught by WINTER et al when the printing job includes images.

As for dep. claim 2 (part of 1), which deals with the intended use of the voucher, i.e. ascertaining printouts of images, this carries no patentable weight in an apparatus claim which only gives patentable weight to system structural elements or structures. Moreover, this is also taught in SEVCIK et al Fig. 7.

As for dep. claim 3 (part of 1), which deals with other elements of the print order acceptance system, i.e. means for displaying images, this is shown in Fig. 3A, 4, or 6A of WINTER et al or Figs. 7-8 of SEVCIK et al.

As for dep. claims 4, 5 (part of 1), which deals with the type of images received and/or produced, i.e. thumbnail images, these are fairly taught in Figs. 3A or 4 or 6A of WINTER et al.

As for dep. claim 16 (part of 1), which further limits the deals with the feature of the thumbnail images, this has no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. Moreover, this is taught in WINTER et al Fig. 3A, and 6A.

As for dep. claims 17-18, 19-20 (part of 1), which deal with how the voucher printer operates, these are inherently included in the teachings of WINTER et al and/or WINTER et al /SEVCIK et al. Furthermore, they have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

As for independent method¹ claim 10, which is the respective method of the system claim 1 above, it's rejected over the steps to carry out the system of WINTER et al or WINTER et al /SEVCIK et al as shown in the rejection of claim 1 above.

As for dep. claim 22, which is not positively cited but is passively recited, it's interpreted as being capable of, and the data and order information of WINTER et al or WINTER et al /SEVCIK is capable of this feature.

As for independent system claim 6, which has similar limitation as in independent system claim 1, part (a) and wherein part (b) has an electronic mail transmission means which transmits the combination of proof sheet and order information to the order user, the teaching of electronic mail transmission means for transmitting digital images and information is taught in WINTER et al, col. 1, lines 25-30, col. 6, lines 10-60, and col. 8, lines 25-55. Also, this is taught in Fig. 1A, col. 1.

As for dep. claims 7, 8, 9 (part of 6 above), these are fairly taught in WINTER et al Figs. 3A, 4, 6A, or SEVCIK et al Figs. 1, 18.

As for dep. 12 (part of 6), which has similar limitations as in dep. 13 above, it's rejected for the same reasons set forth in dep. claim 13 above.

As for dep. 15 (part of 6), the use of other well known Internet network communication devices, such as cellular phone, for use with the system above would have been obvious to a skilled artisan as mere using other well known communication devices such as portable for convenience or portable communication.

As for dep. claim 21 (part of 6), which deal with how the voucher printer operates, these are inherently included in the teachings of WINTER et al and/or WINTER et al /SEVCIK et al. Furthermore, they have no structural elements and does not further limit the printer or acceptance machine of claim 1, resulting in on patentable weight. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. Manner of operating the device does not differentiate apparatus claim from the prior art. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Circuit 1997). Ex Parte Masham, 2 USPQ2d 1647.

As for independent method² claims 11, which is the respective method of the system claim 6 above, it's rejected over the steps to carry out the system of WINTER et al or WINTER et al /SEVCIK et al as shown in the rejection of claim 1 above.

As for dep. claim 13 (part of 11), which deals with well known email parameter, this is inherently including in the email communication of WINTER et al.

As for dep. claim 23 (part of 11), which is not positively cited but is passively recited, it's interpreted as being capable of, and the data and order information of WINTER et al or WINTER et al /SEVCIK is capable of this feature.

As for independent system³ claim 24, which has similar limitation as in independent system claim 1, part (a) and wherein part (b) has an electronic mail

transmission means which transmits the combination of proof sheet and order information to the order user, the teaching of electronic mail transmission means for transmitting digital images and information is taught in WINTER et al, col. 1, lines 25-30, col. 6, lines 10-60, and col. 8, lines 25-55. Also, this is taught in Fig. 1A, col. 1.

Note above, item (5) Similarly, in claim 24, which has similar limitation in (a), it's interpreted for the same reason set forth in item (1) above.

6) Similarly, in claim 6, element (b), the phrase "which prints a voucher ... to the image printer", which has similar issue as item (2) of claim 1, it's interpreted for the same reason set forth in item (2) above.

8. Dep. claim 15 is rejected (2nd) under 35 U.S.C. 103(a) as being unpatentable over WINTER et al and/or SEVCIK et al as applied to claims 6-9, 12 above, and further in view of CONE et al or NARAYANASWAMY et al.

The teachings of WINTER et al and WINTER et al /SEVCIK et al is cited above. CONE et al or NARAYANASWAMY et al is cited to teach the use of portable cellular phone with screen for viewing of virtual image of video information received via a wireless communication network {see CONE et al Fig. 1, or 2 or [0004, 0021], or NARAYANASWAMY et al Fig. 1A, 1B or Fig. 4, col. 2, lines 20-30}. It would have been obvious to modify the Internet communication of WINTER et al /SEVCIK et al by using portable cellular phone with screen for viewing of virtual image of video information received via a wireless communication network as taught by CONE et al or

NARAYANASWAMY et al to allow viewing of virtual image of video information if desired.

9. Claims 6-9, 12, 15, 21 (system) and 11 and 13, 23 (method) are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over GARFINKLE et al and SEVCIK et al.

As for claim 6, GARFINKLE et al fairly teaches the claimed invention except for the item or voucher or proof sheet including other information such as order information. {see Fig. 1, Fig. 6, and Fig. 8}.

In a similar printing job, **SEVCIK et al** is cited to teach the concept of confirming a job after customer order wherein the confirming order including details of the orders such as the printing selections and ordered information and billing information and displaying the "confirming job" information to the customer prior to carrying out the job to inherently obtain the well known benefits of eliminating wastes due to carrying out the job using wrong information or not customer desired job or information {see Fig. 7, right hand picture, "Are you sure you wish to begin this job"}.

It would have been obvious modify the teachings of GARFINKLE et al by modifying the ordering feature to include a confirming feature prior to carrying out the printing job as taught by SEVCIK et al above to obtain the inherent benefit of eliminating waste due to wrong order and wherein the confirmation is a combination of proof sheet which include ordered thumbnail images and order form contains other relevant

information such as ordered information as taught by GARFINKLE et al when the printing job includes images.

As for dep. claims 7, 8, 9 (part of 6 above), these are fairly taught in GARFINKLE et al Figs. 1, 2, 6 and 8 or SEVCIK et al Figs. 1, 18.

As for dep. claim 12 (part of 6), which has similar limitations as in dep. 13 above, it's rejected for the same reasons set forth in dep. claim 13 above.

As for dep. claim 15 (part of 6), the use of other well known Internet network communication devices, such as cellular phone, for use with the system above would have been obvious to a skilled artisan as mere using other well known communication devices such as portable for convenience or portable communication.

As for dep. claim 21 (part of 6), it's rejected for the same reason set forth above.

As for independent method² claims 11, which is the respective method of the system claim 6 above, it's rejected over the steps to carry out the system of GARFINKLE et al /SEVCIK et al as shown in the rejection of claim 1 above.

As for dep. 13 (part of 11), which deals with well known email parameter, this is inherently including in the email communication of GARFINKLE et al.

As for dep. claim 23 (part of 11), it's rejected for the same reason set forth above.

No claims are allowed.

Response to Arguments

10. Applicant's arguments with respect to above claims on 7/17/08 have been considered but are moot in view of the new claim interpretations as shown on the "Notes (6)-(7)" with respect to claim interpretation/limitations/patentable weight above and new ground(s) of rejection which are caused by applicant's amendment of the claims.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689